

28 AUG 2002



UNITED STATES PATENT AND TRADEMARK OFFICE

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Cheryl L. Gastineau
REED SMITH SHAW & MCCLAY LLP
435 Sixth Avenue
Pittsburgh, PA 15219-1886

In re Application of	:	
IYER et al.	:	
Application No.: 09/581,122	:	DECISION ON PETITION
PCT No.: PCT/US98/12394	:	UNDER 37 CFR 1.47(a)
Int. Filing: 15 June 1998	:	
Priority Date: 17 June 1997	:	
Attorney Docket No.: 98-503-W0	:	
For: FETAL OXIMETRY SYSTEM AND	:	
SENSOR	:	

This is a response to applicants' "Second Renewed Petition Under 37 CFR 1.47(a)" filed 03 June 2002 to accept the application without the signatures of joint inventors, Robert M. Johnson, Johannes Buschmann, Reinhold Falkowski, and Nick Tu.

BACKGROUND

On 15 June 1998, applicants filed international application PCT/US98/12394, which designated the United States. A Demand for international preliminary examination electing the United States was filed prior to the expiration of 19 months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 17 December 1999.

On 20 December 1999, applicant filed a transmittal for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and a petition to revive under 37 CFR 1.137(b). The petition to revive was granted in a decision dated 16 August 2000.

On 12 February 2001, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a one-month time limit in which to respond.

On 11 June 2001, applicant filed the petition under 37 CFR 1.47(a) and a petition for a four-month extension of time. The petition was dismissed in a decision dated 12 September 2001.

On 14 January 2002, applicant filed the renewed petition under 37 CFR 1.47(a). The petition was dismissed in a decision dated 03 April 2002.

On 03 June 2002, applicant filed the present petition.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor. Items (1), (3) and (4) have been satisfied.

Regarding item (2) above, Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47. Such a petition will be dismissed as inappropriate.

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

a. Inventor Robert M. Johnson

The steps taken are sufficient to establish that Robert M. Johnson is unavailable to sign the declaration.

b. Inventor Johannes Buschmann

A review of the present petition and the accompanying papers reveal that applicant has satisfied item (2), in that the applicant has shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to

Johannes Buschmann. Additionally, Cheryl Gastineau declares that "Mr. Buschman said that he would not sign the declaration on the advice of his attorney."

c. Inventor Reinhold Falkowski

A review of the present petition and the accompanying papers reveal that applicant has satisfied item (2), in that the applicant has shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to Reinhold Falkowski. Additionally, Cheryl Gastineau declares that "Mr. Falkowski said that he would not sign the declaration on the advice of his attorney."

d. Inventor Nick Tu

A review of the present petition and the accompanying papers reveal that applicant has satisfied item (2), in that the applicant has shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to Nick Tu. Additionally, Cheryl Gastineau declares that "Mr. Tu said that he would not sign the declaration."

CONCLUSION

The renewed petition under 37 CFR 1.47(a) is **GRANTED**.

The application will be given an international filing date of 15 June 1998 under 35 U.S.C. 363, and a date of **14 January 2002** under 35 U.S.C. 371(c).

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the nonsigning inventors at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

This application is being returned to the United States Designated/Elected Office for processing in accordance with this decision.

The correspondence address listed on the declaration filed 14 January 2002 and the correspondence address listed in the PALM database are inconsistent. In order to change the correspondence address, applicants must file the proper papers pursuant to 37 CFR 1.33 and MPEP 601.03.



Leonard Smith
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Reinhold Falkowski
Birkenleiten 9
D81453 Munich
Federal Republic of Germany

In re Application of
IYER et al.
Application No.: 09/581,122
PCT No.: PCT/US98/12394
Int. Filing: 15 June 1998
Priority Date: 17 June 1997
Attorney Docket No.: 98-503-W0
For: FETAL OXIMETRY SYSTEM AND SENSOR

Dear Mr. Falkowski:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.497.

Handwritten signature of Boris Milef in black ink.

for Boris Milef
PCT Legal Examiner
Office of PCT Legal Administration

Handwritten signature of Anthony Smith in black ink.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
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OFFICIAL GAZETTE NOTICE

37 CFR 1.47 Notice by Publication

Notice is hereby given of the filing of an national stage application with a petition under 37 CFR 1.47 requesting acceptance of the application without the signature of all inventors. The petition has been granted. A notice has been sent to the last known address of the non-signing inventors. The inventors whose signatures are missing (Robert M. Johnson, Johannes Buschmann, Reinhold Falkowski, and Nick Tu) may join in the application by promptly filing an appropriate oath or Declaration complying with 37 CFR 1.497. The international application number is PCT/US98/12394 and was filed on 15 June 1998 in the name of Vijay Iyer, Robert M. Johnson, Johannes Buschmann, Reinhold Falkowsk, Christopher Cutler, William D. Wallace, Steven Smith, Daniel McGraw, Nick Tu, Clifford G. Montagnoli, and Trent W. Banks for the invention entitled FETAL OXIMETRY SYSTEM AND SENSOR. The national stage application number is 09/581,122 and has a 35 U.S.C. 371 date of 14 January 2002.



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Nick Tu
6333 Lauderdale St.
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In re Application of
IYER et al.
Application No.: 09/581,122
PCT No.: PCT/US98/12394
Int. Filing: 15 June 1998
Priority Date: 17 June 1997
Attorney Docket No.: 98-503-W0
For: FETAL OXIMETRY SYSTEM AND SENSOR

Dear Mr. Tu

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.497.

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Johannes Buschmann
Birkenleiten 9
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In re Application of
IYER et al.
Application No.: 09/581,122
PCT No.: PCT/US98/12394
Int. Filing: 15 June 1998
Priority Date: 17 June 1997
Attorney Docket No.: 98-503-W0
For: FETAL OXIMETRY SYSTEM AND SENSOR

Dear Mr. Buschmann:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.497.

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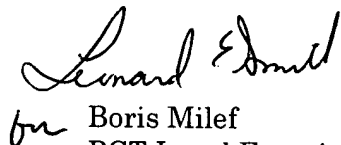
Robert M. Johnson
481 Ivy Park Lane
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In re Application of
IYER et al.
Application No.: 09/581,122
PCT No.: PCT/US98/12394
Int. Filing: 15 June 1998
Priority Date: 17 June 1997
Attorney Docket No.: 98-503-W0
For: FETAL OXIMETRY SYSTEM AND SENSOR

Dear Mr. Johnson:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

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